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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,328	02/15/2001	Kazuhiko Nobe	Q63117	3179

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EXAMINER
JONES, SCOTT E

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/05/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)	
	09/783,328	NOBE ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on *15 February 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. This office action is in response to the request for reconsideration filed on February 27, 2003 in which applicant responds to the claim rejections.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sagawa et al. (E.P. 903,169 A2) in view of Olmedo (U.S. 6,174,170).

Sagawa et al. discloses a music action game machine wherein as the music game machine plays music, it simultaneously provides operation instructions to a player indicative of when to operate a game controller in time with the music. Sagawa et al. additionally discloses:

Regarding Claims 1-8, and 11-13:

- means to play music from a commercially available music CD (Abstract, Column 1, lines 26-31, Column 9, lines 37-46, Figure 6 (56), and Claim 1);
- operation timing data storage means for storing instructions for when a player should operate the controller to meet preprogrammed game criteria based on the music played from the commercially available music CD (Abstract, Column 1, lines 32-36, Column 3, lines 26-42, Column 8, line 46-Column 9, line 46, and Claim 1); and
- music game execution means to execute the game (Abstract, Column 1, lines 32-36, Column 3, lines 26-42, Column 8, line 46-Column 9, line 46, and Claim 1).

Regarding claims 1-8, and 11-13, Sagawa et al. seems to lack explicitly disclosing a judgment means for reading the recorded content of a commercially available music CD and determining whether the commercially available music CD is a predetermined commercially music CD based on the recorded content read.

Olmedo teaches of a method and apparatus for displaying text symbols on a display associated with audio reproduced from a recording disc such as in a Karaoke game. Like Sagawa, Olmedo plays music from a CD or other storage device and simultaneously provides operation instructions on a display (text of the song) in which a player is to sing. Olmedo seems to lack teaching of a player operating a controller to provide an input to the game based upon operation instructions provided to a player. However, one could argue that a player singing into a microphone provides the input to a controller for a Karaoke game machine to evaluate a player's performance. Regarding claims 1-8, and 11-13 , Olmedo teaches of an embodiment wherein the text information of a song may be recorded on a storage medium that is separate and apart from the recording disc on which the audio of a song is stored. The controller senses/judges and identifies text character frames of lyrics for a particular song such that when a song is played text symbols representing the lyrics of the song are displayed on a display (Column 8, line 39-Column 10, line 67).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the features of Olmedo in Sagawa et al. One would be motivated to do so because a player would be given the flexibility to use a music CD from their personal home collection in which to play the game, given the textual information (operation instructions) is already in storage on the game machine.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sagawa et al. (E.P. 903,169 A2) in view of Olmedo (U.S. 6,174,170) and further in view of Ng (U.S. 6,328,570).

Sagawa et al. in view of Olmedo teaches that as discussed above with regards to Claims 1-8, and 11-13. Sagawa et al. in view of Olmedo seems to lack explicitly stating that music data is obtained from a music data distribution server via a communication network (Claims 9 and 10).

Ng teaches of a portable karaoke game unit wherein song and program data may be stored and retrieved from different sources. Ng, Sagawa et al., and Olmedo are analogous art because Ng teaches of a game that that utilizes music and operation timing instructions (lyrics to be sung by player at a particular time in the game). Regarding Claims 9 and 10, Ng teaches that data (song, lyrical, and image) can be downloaded from a variety of sources, one being from the Internet, for storage on a removable storage medium (CD-ROM) (Column 1, line 49-Column 2, line 5). It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the data acquisition feature of Ng in the combination of Sagawa et al. in view of Olmedo. One would be motivated to do so because it provides a game machine that is more flexible in the manner in which it may be used than existing systems.

Response to Arguments

5. Applicant's arguments filed February 27, 2003 have been fully considered but they are not persuasive.

Applicant's traverse the rejection to Claims 1-8, and 11-13 under 35 U.S.C. 103(a) as being unpatentable over Sagawa et al. in view of Olmedo.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues Sagawa et al. lacks the ability to use a "commercially available music CD." The examiner agrees on this point. A commercially available

music CD is one that contains music only, not game timing or programming data. Sagawa et al. discloses everything except for the ability to use a "commercially available music CD." Sagawa et al. discloses a musical action game machine operable on the basis of a single CD-ROM disc that contains music, timing, and programming data.

Applicant argues Sagawa et al. lacks various elements of the invention because there is no teaching of an execution on the basis of music read from a commercially available music CD. In this case, Applicant is arguing the references piecemeal rather than addressing the combination as a whole. The examiner does not rely on Sagawa et al. to teach the ability to use a commercially available music CD to play a game. The examiner relies on Olmedo to teach this feature.

Applicant alleges Olmedo's karaoke machine is wholly different than Applicant's music game machine. The examiner disagrees because both Sagawa et al. and Olmedo both disclose music games that play music and provide operating instructions and programming to play a game.

Applicant alleges, in a second embodiment, Olmedo uses a standard CD (commercially available music CD), but requires a second specialized timing CD as well to play the game. However, column 8, lines 39-53 teach the separate storage medium on which the text characters are stored may be a storage cartridge which contains a memory board on which text characters are stored. Therefore, a second "CD" is not necessarily required, but a second "separate" storage means is required to store game instructions and programming. This feature is similar to Applicant's invention.

Applicant alleges Olmedo provides text of a song on a display, but does not provide operation timing data indicative of timings at which a player should operate a controller in accordance with game music. The examiner asserts Olmedo's system which provides text of a song on a display is equivalent to operation timing data indicative of timings at which a player should

operate a controller in accordance with the game music as claimed by Applicant. The examiner relies on Olmedo solely to teach that a commercially available music CD can be used in a game system (karaoke machine) wherein game timing/programming data is stored on a separate storage medium which is different than the commercially available music CD.

For the reasons discussed hereinabove, the examiner maintains the rejection.

6. Regarding the rejection to claims 9-10 under 35 U.S.C. 103(a) as being unpatentable over Sagawa et al. in view of Olmedo and further in view of Ng, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

For the reasons discussed hereinabove, the examiner maintains the rejection.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SRJ

sej
April 28, 2003

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700